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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,541	01/28/2004	David Robison	CRS / 275	3109

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EXAMINER

GRAY, LINDA L

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,541

Applicant(s)

ROBISON ET AL.

Examiner

Linda L. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 1-3 and 8 is/are allowed.
6) ☒ Claim(s) 4 and 5 is/are rejected.
7) ☒ Claim(s) 6-7 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 2/2
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

Detailed Action

Claim Rejections - 35 USC 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Liebmann (US 6,212,683 B1).

Claim 4, Liebmann teaches apparatus 28 capable of applying seam tape 14 along an edge of membrane 20 where apparatus 28 includes a seam tape applicator (Fig 3A) having contact roll 53 adapted to press tape 14 against a surface of membrane 20. The applicator supports roll 36 of tape 14. Tape 14 includes pressure sensitive layer 15 having first and second adhesive surfaces and release sheet 12 covering one of the surfaces. Apparatus 28 also includes slit 60 adapted to slit through tape 14 and membrane 20.

With respect to the limitation that the membrane be a roofing membrane per se, this refers to the material operated upon by the claimed apparatus and does not provide a patentable distinction between Liebmann and claim 4.

Claim 5, Liebmann teaches guides including roller for 50 which guides membrane 20 into a roll and a guide roll under slit 60.

Allowable Subject Matter

4. Claims 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-3 and 8 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter:

claim 1, although Liebmann teaches a method of applying seam tape 14 (Fig 3A) along an edge of sheet of membrane 20 wherein (a) tape 14 includes pressure sensitive

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adhesive strip 15 covered on a first surface with release sheet 12 (Fig 5; c 6, L 1-14), (b) the method includes applying tape 14 to a center portion of membrane 20 by pressing a second surface of tape 14 against membrane 20 at item 53 and cutting membrane 20 into two sheets at item 60 by cutting through membrane 20 and tape 14 to form the two sheets having tape 14 along one edge (Fig 3B) (c 3-5 for related discussion), and (c) the limitation of "adapted for use as one of a roofing membrane and a pond liner" is related to an intended use of the sheets made using the presently claimed method and does not provide a patentable distinction between Liebmann and claim 1, Liebmann does not teach cutting through membrane 20 and tape 14 along a central portion of tape 14 where the two sheets formed having a continuous portion of tape 14 along one edge in that the sheets of Liebmann (Fig 3A) after cutting (but before being cut across via cutter 62) have a discontinuous portion of tape 14 along one edge at area 13 (Fig 3B) and the other edge (Figs 3A, 3B) does not the continuous portion of tape 14 along it because tape 14 is space from this edge,

claim 6: Liebmann does not teach the guides to include a plurality of disks located along the central axis of apparatus 28, and

claim 7: Liebmann does not teach apparatus 28 to include a handle providing means to push apparatus 28 over membrane 20 in that in that items 52, 53, and 60 are stationary relative to moving membrane 20.

6. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response

7. Applicant's comments filed June 21, 2005 have been fully considered.

Although claim 1 is allowed, several comments are necessary. The limitation of "adapted for use as one of a roofing membrane and a pond liner" has been considered but does not provide a patentable distinction between Liebmann and the method of claim 1 because the limitation refers to an intended use of the sheets made using the presently claimed method. The limitation does not further limit the steps of the claimed method. Applicant argued otherwise.

For claim 1, also, Applicant indicates that Liebmann should not be used in a rejection because the reference deals with plastic bibs for use in a dental office and no one skilled in the art would look to plastic bib making to learn how to make membrane

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roofing. In response, each step of the method of claim 1 is taught by the reference (except for the steps which deem claim 1 allowable). The limitation in claim 1 of "adapted for use as one of a roofing membrane and a pond liner" refers to an intended use of the sheets made using the presently claimed method. The limitation does not further limit the steps of the claimed method. The limitation does not limit claim 1 to making roofing membranes, and claim 1 is written in such a manner as to include the bib making method of the reference.

The allowability of claims 4-7 is withdrawn as shown above, and prosecution is reopened with withdrawn of finality.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

llg
July 14, 2005


LINDA GRAY
PRIMARY EXAMINER